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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/830,172	04/21/2004	Ralf Schliephacke	101769-254 (tesa AG 1635)	8156
27384 7590 10/24/2008 NORRIS, MCLAUGHLIN & MARCUS, PA 875 THIRD AVENUE 18TH FLOOR NEW YORK, NY 10022				
EXAMINER				
SELLS, JAMES D				
ART UNIT		PAPER NUMBER		
1791				
MAIL DATE		DELIVERY MODE		
10/24/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/830,172

**Applicant(s)**

SCHLIEPHACKE ET AL.

**Examiner**

James Sells

**Art Unit**

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. In view of the appeal brief filed on 08/06/2008, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Philip C Tucker/

Supervisory Patent Examiner, Art Unit 1791

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khatib (US Patent 5,370,420) in view of Treleaven (US Patent 6,413,345).

Regarding claim 1, Khatib discloses a method of making pressure sensitive labels. As shown in the figure, the method involves providing a face sheet 24 on web 12. Face sheet 24 is provided with a pressure sensitive adhesive on its underside (see col. 2, lines 31-33). Face sheet 24 is die cut vertically and horizontally along lines 28, 30, 32 and 34 to form individual labels 26 (see col. 2, lines 38-45). These cross die cuts extend over the entire width of face sheet 24 in the manner claimed by the applicant. In addition, the specification only describes die cutting face sheet 24, not web 12 and the figure only shows the die cuts in face sheet 24, not in web 12. Therefore during the cross diecutting, the backing material (web 12) is not cut into or is only cut into insignificantly in the manner claimed by the applicant. Web 12 comprises a release coated liner that is coated on the upper surface with a conventional release coating (see col. 2, lines 25-28).

However, Khatib does not disclose the die cut line configuration as claimed by the applicant. Regarding this difference, the applicant is directed to the reference of Treleaven.

Treleaven discloses a method for making labels. This method employs die cut station 30 to for tear lines 135A, 135B, 155A, 155B and 158 in the labels. In particular, Figs. 2 shows the tear lines with a saw-toothed configuration.

It would have been obvious to one having ordinary skill in the art to employ a saw-toothed tear line, as taught by Treleaven, in the method of Khatib as a matter of choice based on desired physical properties (i.e. ease and effectiveness of use by the consumer) and functionality of the labels being produced. In addition, since both Khatib and Treleaven teach cut lines, it would have been obvious to one having ordinary skill in the art to substitute one type of cut line for another in order to achieve predictable results.

Regarding claim 2, the figure of Khatib shows diecuts 28, 30, 32 and 34 surrounding labels 26. The top and bottom portions of these diecuts are cut at an angle of substantially 90° in relation to the direction of the web in the manner claimed by the applicant.

Regarding claim 3, Figs. 2-3 and 8 of Treleaven shows dies cut tear lines with a sawtooth-like or zigzag-formed pattern. Motivation has been provided above (see the rejection of claim 1) to employ these die-cut tear lines of Treleaven in the method of Khatib.

Regarding claim 4, Khatib discloses the web of labels (face sheet 24) includes a pressure sensitive adhesive layer its underside (see col. 2, lines 31-33).

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Khatib in view of Treleven as described above in paragraph 3 in further view of Bausewein et al (US Patent 5,482,779).

Regarding claim 5, Khatib does not disclose the anti-adhesive coating on both sides of the backing materials as claimed by the applicant. Regarding this difference, the applicant is directed to the reference of Bausewein

Bausewein discloses a process for manufacturing a label. As shown in Fig. 1, the label product 12 comprises printable recording medium or film 1, adhesive layer 2, intermediate layer 4, adhesive layer 4 and carrier sheet or foil 5. At col. 5, lines 30-36, Bausewein discloses that carrier foil 5 can preferably be coated on both sides with silicone in order to produce a primary laminated material which can serve as the base material for receiving a variety of printable materials thereon.

It would have been obvious to one having ordinary skill in the art to employ carrier or backing material with an anti-adhesive material coating on both sides thereof, as taught by Bausewein, in the method of Khatib in order to provide the predictable result of providing a carrier material which can serve as the base material for receiving a variety of printable materials thereon. In addition, since Bausewein discloses the same silicone material on both sides of the backing or carrier material, it is the examiner's

position that these silicone coatings inherently do not differ substantially in the degree to which they repel the same layer of adhesive in the manner claimed by the applicant.

### ***Response to Arguments***

5. Applicant's arguments filed August 6, 2008 have been fully considered but they are not persuasive.

Applicant argues there is no motivation to substitute of a saw-toothed tear line for a straight line. The examiner does not agree. As stated above, it would have been obvious to one having ordinary skill in the art to employ a saw-toothed tear line, as taught by Treleaven, in the method of Khatib as a matter of choice based on desired physical properties (i.e. ease and effectiveness of use by the consumer) and functionality of the labels being produced. In addition, since both Khatib and Treleaven teach cut lines, it would have been obvious to one having ordinary skill in the art to substitute one type of cut line for another in order to achieve predictable results. Therefore applicant's argument is believed to be incorrect in this instance.

Applicant argues employing an undular cross-diecutting enables a maximum application rate of 2.0 m/s while the maximum application rate for a straight cross-diecutting is only 0.3 m/s. However, it is noted that such limitations are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore applicant's argument is believed to be irrelevant in this instance.

Applicant asserts the examiner has conceded that the above data concerning the maximum application rates demonstrate a surprising and unexpected result by stating "Applicant argues the invention has the surprising effect of increasing the speed with which diecuts can be applied. This may be true. ". That is not the case. The applicant has reached the wrong conclusion and has taken the examiner's statement out of context. The next statement made by the examiner is "However, applicant's claims do not contain any limitations concerning the speed with which diecuts can be applied.". The point the examiner was trying to make was that applicant's alleged surprising and unexpected results are irrelevant since the limitations are not recited in the rejected claims.

The rest of applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

#### ***References***

6. References C-D are cited as prior art of interest.

#### ***Telephone/Fax***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sells whose telephone number is (571) 272-1237. The examiner can normally be reached on Monday-Friday.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phil Tucker can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Sells/  
Primary Examiner, Art Unit 1791